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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,564	12/01/2000	Yoshiya Nonaka	P107156-00031	1817
4372 7590 01/23/2007 ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/726,564

Applicant(s)

NONAKA ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communication: 2 November 2006 with acknowledgement of an original application filed on 1 December 2000 with recognition of a foreign priority date of 8 December 1999.
2. Claims 1-6 are currently pending in this application. Claims 1, 3, and 5 are independent claims. Claims 3 and 5 have been amended, amendment to the claims is accepted.

Response to Arguments

3. Applicant's arguments with respect to 1-6 have been considered but they are not persuasive.

In response to Applicant's argument on page beginning on page 6, "*The Applicants traverse the rejection and respectfully submit that claims 1-6 recite subject matter that is neither disclosed nor suggested by Newell. As a result of the claimed invention, when the information data recorded in the first medium is to be recorded in the second recording medium (for backup for example), the information data is at first encrypted in accordance with the identification data of the second recording medium and then recorded in the second recording medium. Accordingly, the content recorded in the second recording medium may be made different from that recorded in the first recording medium. Therefore, it is possible to prevent unlawful copying, while at the same time allowing lawful user to perform data recording for the purpose of data backup. In this way, if the information data recorded in the first recording medium is accidentally destroyed, the same data can be restored in accordance with the identification data*". The Examiner disagrees with the above argument for multiple reasons. One applicant is placing numerous limitations that are not present in the claims, for example:

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1st nowhere in the claims is it indicated that the second recording information is a backup

2nd the sentence “*Accordingly, the content recorded in the second recording medium may be made different from that recorded in the first recording medium.*” is not in the claims and has no understood bearing on the arguments presented.

3rd nowhere in the claims is it indicated information data recorded in the first recording medium is accidentally destroyed

In addition the Examiner disagrees with the arguments presented because all of the claimed features are suggested in Newell. For Example Newell indicates in col. 4, lines 40-47 that the host computer may be programmed to allow for archival copying. The Examiner interprets archival to have the same meaning as backup. Also, Newell indicates in col. 3, lines 43-51 that the information on drive 2 can be decrypted. This decryption of information and reading the contents is considered to be equivalent to ‘restored’. Furthermore, the identification data is considered to be equivalent to ID_y, the first recording medium is considered equivalent to SM₁, the second recorded medium is considered equivalent to SM₂. The encryption and decryption described is in accordance with the key identified with the storage mediums identified.

In response to Applicants arguments beginning on page 7, “*The Applicants respectfully submit that Newell fails to disclose or suggest the features of the invention as recited in claims 1, 3, and 5 ... In contrast, Newell merely discloses preventing unlawful copying of recorded information, but fails to disclose or suggest preparing a backup copy for an individual’s legally obtained data to make it possible to reproduce accidentally destroyed data as recited in claims 1,*

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3, and 5". The Examiner disagrees with argument and notes again the Applicant is placing limitations from the specification into the claims, nowhere in the claims is it indicated that the second recording information is a backup and nowhere in the claims is it indicated information data recorded in the first recording medium is accidentally destroyed. Furthermore Newell indicates in col. 4, lines 40-47 that the host computer may be programmed to allow for archival copying. The Examiner interprets archival to have the same meaning as backup. Also, Newell indicates in col. 3, lines 43-51 that the information on drive 2 can be decrypted. This decryption of information and reading the contents is considered to be equivalent to 'restored'.

In response to Applicants argument on page 8, *"As such, there is no disclosure or suggesting in Newell of the claimed method comprising the step of encrypting the first encrypted information data so as to produce a second encrypted information data and recording the second encrypted information data in the second recording medium as recited in claim 1"*. The Examiner disagrees the rejection below in which Newell teaches an archival copy may be generated col. 4, lines 40-47, as well as that information in storage mediums may be read or displayed by computer system if the matching key is present col. 3, lines 5-12 and col. 3, lines 43-51. Note being able to use the data on a computer system is considered equivalent to 'restored'.

In response to Applicants argument on page 8, *"As such, there is no disclosure or suggestion in Newell of the claimed method ... a system for recording/reading information data, wherein the first encrypted information data is recorded as the second encrypted information data in the second recording medium without being decoded, as recited in claim 3"*. The Examiner disagree with argument and notes that Claim 3 was amended to incorporate this

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feature, however it is also taught in Newell see col. 4, lines 28-39 which indicates that information is a second recording medium is not decrypted, i.e. decoded without a corresponding matching key.

In response to Applicants argument beginning on page 8, *"Further there is no disclosure or suggestion in Newell that recorded in the second recording means is second encrypted information data formed by encrypting the first encrypted information data in accordance with identification data of the second recording medium, which is first encrypted information data is formed through encryption in accordance with identification data of the first recording medium decoded first encryption information data is recorded in the first recording medium decoded without being further decoded, as recited in claim 5"*. The Examiner disagrees with arguments presented and notes that Claim 5 was amended to incorporate this feature, however it is also taught in Newell see col. 4, lines 3-39, which indicates that the when copy contents from storage medium that it is encrypted in accordance with the identification data of the storage medium it is being copied to. In addition in order to decrypt or decode the information a matching key is needed. This is equivalent to 'without further being decoded'.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Newell U.S. Patent No. 5,651,064 (hereinafter '064).

As to independent claim 1, **“A method for recording/reading information data using a first recording medium and a second recording medium each having its own identification data, said method comprising the steps of:”** and **“encrypting the first encrypted information data in accordance with an identification data of the second recording medium, so as to produce second encrypted information data; recording the second encrypted information data in the second recording medium”** and **“restoring the second encrypted information data into the first encrypted information data and recording the information data in the first recording medium”** is taught in '064 col. 4, lines 40-47;

“reading first encrypted information data encrypted in accordance with an identification data of the first recording medium and recorded in said first recording medium” is shown in '064 col. 3, lines 5-12;

“reading the second encrypted information data from the second recording medium and decoding the second encrypted information data in accordance with the identification data of the second recording medium” is disclosed in '064 col. 3, lines 43-51.

As to dependent claim 2, **“wherein mutual confirmation is performed between the first recording medium and the second recording medium to confirm whether these recording mediums are formally registered, an encrypted information data is read out from the first recording medium or the second recording medium if the mutual confirmation shows that the first and second recording mediums are formally registered”** is taught in '064 col. 3, lines 65-67 (“confirmation” same as “polling”).

As to independent claim 3, “A system for recording/reading information data, wherein first encrypted information data encrypted in accordance with an identification of a first recording medium is read out from the first recording medium, the first encrypted information data is then recorded in a second recording medium, the system comprising:” and “encrypting means for encrypting the first encrypted information data in accordance with an identification data of the second recording medium, so as to produce second encrypted information data; recording means for recording the second encrypted information data in the second recording medium” is taught in ‘064 col. 4, lines 40-47;

“reading means for reading first encrypted information data from the first recording medium” is shown in ‘064 col. 3, lines 5-12;

“wherein the first encrypted information data is recorded as the second encrypted information data in the second recording medium without being decoded” is disclosed in ‘064 col. 4, lines 28-39 which indicates that information is a second recording medium is not decrypted, i.e. decoded without a corresponding matching key.

As to dependent claim 4, this claim is substantially similar to claim 2 and is rejected along the same rationale.

As to independent claim 5, “A system for recording/reading information data, wherein second encrypted information data encrypted in accordance with identification data of a second recording medium is read out from the second recording medium” and “the system comprising: reading means for reading second encrypted information data from the second recording medium” and “decoding means for decoding the second

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encrypted information data in accordance with identification data of the second recording means” is taught in ‘064 col. 3, lines 43-51;

“the second encrypted information data is then recorded in a first recording medium” and “recording means for restoring the second encrypted information data into the first encrypted information data so as to record the information data in the first recording medium” is shown in ‘064 col. 4, lines 40-47;

“wherein recorded in the second recording means is second encrypted information data formed by encrypting the first encrypted information data in accordance with identification data of the second recording medium, which first encrypted information is formed through encryption in accordance with identification data of the first recording medium” is disclosed in ‘064 col. 4, lines 3-44, which indicates that the when copy contents from storage medium that it is encrypted in accordance with the identification data of the storage medium it is being copied to;

“wherein the decoded first encrypted information data is recorded in the first recording medium without being further decoded” is taught in ‘064 col. 4, lines 28-39 which indicates that information is a second recording medium is not decrypted, i.e. decoded without a corresponding matching key

As to dependent claim 6, “wherein the reading means comprises: confirmation means for performing a mutual confirmation between the first recording medium and the second recording medium; allowance issuing means for issuing an allowance for reading the second encrypted information data when the confirmation means confirms that the first recording medium and the second recording medium are all formally registered” is taught in ‘064 col. 3, lines 65-67 (“confirmation” same as “polling”).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ECT
Ellen Tran
Patent Examiner
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18 January 2007


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PRIMARY EXAMINER